

RECEIVED
CENTRAL FAX CENTER
SEP 20 2010

REMARKS

Reconsideration and allowance in view of the following remarks are respectfully requested.

Upon entry of this Response, claims 27-32 and 46-61 will be pending in the present application.

Claims 27, 30 and 46 have been amended in this response.

Claims 1-26 and 33-45 were previously cancelled.

Claim Objections

The Examiner objects to Claim 30 due to the informality that the word "comprises" was deleted from the claim. Claim 30 have been amended to correct such informality.

Claims 27-32: Rejected Under 35 U.S.C. § 112, second paragraph

The Examiner rejects Claims 27-32 under 35 U.S.C. § 112, second paragraph as failing to set forth the subject matter which applicant(s) regard as their invention. Claim 27, from which Claims 28-32 depend, has been amended as suggest by the Examiner to clarify the subject matter being claimed and is thus believed to overcome the rejection.

Withdrawal of the rejection of Claims 27-32 under 35 U.S.C. § 112, second paragraph is respectfully requested.

Claims 27-32 and 46-49: Rejected Under 35 U.S.C. § 102(b)

The Examiner rejects Claims 27-32 and 46-49 under 35 U.S.C. § 102(b) as being anticipated by Nakajima (U.S. 6,355,036 B1, hereinafter "Nakajima"). It is respectfully submitted that Nakajima fails to disclose or suggest all of the elements recited in the claims and therefore fails to anticipate the claims.

Claim 27, as presently amended, recites an implant for attachment to a hyoid bone, comprising: an implant body; a first attachment zone configured for attachment to a first portion of a hyoid bone; a second attachment zone configured for attachment to a second portion of a hyoid bone; a connection between the first and second attachment zones which allows a pivotal movement of the first and second attachment zones with respect to each other; and a lock

carried by the body that, when locked, inhibits the pivotal movement between the first and second attachment zones.

An example of such implant is shown in Figs. 13A and 13B of the present application which is described in paragraph [0081]:

In one embodiment, shown in FIGS. 13A and 13B, a configuration lock 67 is located between the two brace arms 39 and is attachable to both brace arms 39. The configuration lock 67 comprises a locking member 68 with at least one interfaceable end 69 and at least one locking interface 70 located on a brace arm 39. When the interfaceable end 67 of the locking member 68 is in contact with the locking interface 70 of the brace arms 39, the locking member 68 limits the movement, if any, of a brace arm 39 relative to the other brace arm 39 or brace arms 39.

In contrast, Nakajima is directed to a bone adjuster for adjusting two opposing bone fragments. Bone adjuster 20 includes first and second lift plates 22, 24 connected via an adjusting shaft 26 that provides for the spacing of the first and second lift plates to be selectively adjusted. Each of the first and second lift plates 22, 24 are each coupled via respective hinges 36, 46 to a respective mounting plate 28, 42 that is secured to a bone fragment via screws 32. In making the rejection, the Examiner identifies mounting plates 28 and 42 as being equivalent to the recited first and second attachment zones as well as hinge 36 as being “a connection between the first and second attachment zones . . . which allows movement of the first and second attachment zones with respect to each other”. The Examiner then further identifies adjusting shaft 26 as being “a lock carried by the body for fixing the relationship between the first and second attachment zones”. However, the adjusting shaft 26 of Nakajima does not inhibit the pivotal movement provided by either of the hinges 36, 46 and thus does not inhibit the pivotal movement between the first and second attachment zones, as recited in claim 27.

Accordingly, Nakajima plainly fails to disclose or suggest “*a connection between the first and second attachment zones which allows a pivotal movement of the first and second attachment zones with respect to each other; and a lock carried by the body that, when locked, inhibits the pivotal movement between the first and second attachment zones*” as recited in claim 27.

As such, Claim 27 should be allowed over Nakajima. Claims 28-32 depend from Claim 27 and as such should likewise be allowed over Nakajima for at least the same reasons as Claim 27.

Similar to Claim 27, claim 46 recites “a connection between the first and second contact zones which allows a pivotal movement of the first and second contact zones with respect to each other; and a lock carried by the body, for fixing the pivotal movement between the first and second contact zones” and as such should also be allowed over Nakajima. Claims 47-49 depend from Claim 46 and as such should likewise be allowed over Nakajima for at least the same reasons as Claim 46.

Withdrawal of the rejection of Claims 27-32 and 46-49 under 35 U.S.C. § 102(b) is respectfully requested.

Claims 27-32, 50, 51 and 58-61: Rejected Under 35 U.S.C. § 102(b)

The Examiner alternately rejects Claims 27-32, 50, 51 and 58-61 under 35 U.S.C. § 102(b) as being anticipated by Jackson (U.S. 6,685,742 B1, hereinafter “Jackson”). It is respectfully submitted that Jackson fails to disclose or suggest all of the elements recited in the claims and therefore fails to anticipate the claims.

As previously discussed, Claim 27 recites, *inter alia*, “an implant for attachment to a hyoid bone, comprising: an implant body; a first attachment zone configured for attachment to a first portion of a hyoid bone” and “a second attachment zone configured for attachment to a second portion of a hyoid bone”.

Jackson discloses an articulated modular spinal fusion cage that is structured for implanting in the invertebral space between adjacent vertebrae. As shown in Fig. 1, the system of Jackson includes a pair of bone supporting surfaces 22 and 50 (see col. 4, lines 4 – 36). Fig. 4 of Jackson shows the system 1 installed between upper and lower adjacent vertebrae 3 and 4 (see col. 3, lines 46-53).

In making the rejection, the Examiner contends that the recitation of “an implant for attachment to a hyoid bone” is an “intended use” and that the implant of Jackson can be attached to the bone by being expanded outwardly by use of the driver 11 to meet two sides of the bone. While it is acknowledged that the limitation “an implant for attachment to a hyoid bone” does contain functional language, it is submitted that regardless of how such limitation is characterized, it should be properly considered for purposes of patentability. In accordance with MPEP 2173.05(g), “[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the

pertinent art in the context in which it is used.” MPEP 2173.05(g), citing *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004); *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971); *In re Land*, USPQ 621 (CCPA 1966)(holding that it is impermissible for the Examiner to refuse to afford patentable weight to functional limitations); *In re Mills*, 16 USPQ 2d 1430 (Fed. Cir. 1990)(holding that the Examiner must afford patentable weight to functional limitations, even if the functional limitations are the only limitations that are nonobvious over the prior art).

Clearly the device taught by Jackson is designed to wedge between opposing faces of two different bone structures. While it is acknowledged that a hyoid bone is generally U-shaped, one skilled in the art would recognize that such an arrangement as disclosed by Jackson would not lend itself for attachment to a single hyoid bone as the only possible way for such device of Jackson to potentially meet all of the recited limitations would make for a device that would be unusable due to its size and required placement. Such device would occupy at least a large portion of the inside portion of the U-shaped bone as there are no other opposing faces for such a device to potentially engage. One skilled in the art would readily appreciate that such space is already occupied by a patient’s pharynx and other necessary components and thus not available for placement of such a suggested device.

Furthermore, the device of Jackson is not actually configured to be attached to anything, as it is not actually attached, but merely wedged between the adjacent bone structures. Hence, at most Jackson suggests a device that would be wedged within the U-shaped portion of a hyoid bone, and not attached as recited in the claim.

Accordingly, it is respectfully submitted that the device of Jackson does not disclose or suggest “an implant for attachment to a hyoid bone, comprising: an implant body; a first attachment zone configured for attachment to a first portion of a hyoid bone” and “a second attachment zone configured for attachment to a second portion of a hyoid bone” as recited in Claim 27 and similarly in Claim 50. Hence it is submitted that Claims 27 and 50 should be allowed over Jackson. Claims 28-32, 51 and 58-61 depend from one of Claims 27 and 50 and as such should likewise be allowed over Jackson for at least the same reasons as Claims 27 and 50.

Withdrawal of the rejection of Claims 27-32, 50, 51 and 58-61 under 35 U.S.C. § 102(b) is respectfully requested.

RECEIVED
CENTRAL FAX CENTER
SEP 20 2010

Claims 52-57: Rejected Under 35 U.S.C. § 103(a)

The Examiner rejects Claims 52-57 under 35 U.S.C. § 103(a) as being unpatentable over Nakajima. Claims 52-57 depend from Claim 50, which, for reasoning similar to that discussed above in connection with claim 27, is believed to be allowable over Nakajima. Accordingly, Claims 52-57 are likewise believed to be allowable over Nakajima.

Withdrawal of the rejection of Claims 52-57 under 35 U.S.C. § 103(a) is respectfully requested.

Claims 52-57: Rejected Under 35 U.S.C. § 103(a)

The Examiner rejects Claims 52-57 under 35 U.S.C. § 103(a) as being unpatentable over Jackson. Claims 52-57 depend from Claim 50, which, for reasoning as discussed above, is believed to be allowable over Jackson. Accordingly, Claims 52-57 are likewise believed to be allowable over Jackson.

Withdrawal of the rejection of Claims 52-57 under 35 U.S.C. § 103(a) is respectfully requested.

Summary and Conclusion

All objections and rejections have been addressed. It is respectfully submitted that the present application is in condition for allowance and a Notice to this effect is earnestly solicited.

Respectfully submitted,
/Stephen A. Bucchianeri/

By: Stephen A. Bucchianeri
Registration No. 54,928
For: Charles E. Kosinski
Registration No. 39,254

Mail all correspondence to:

Charles Kosinski, Esq.
Philips Intellectual Property & Standards
PO Box 3001
Briarcliff Manor, NY 10510-8001, USA
Phone: (724) 387-3746
e-mail: charles.kosinski@philips.com